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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,844	09/08/1999	WILLIAM J. INFOSINO	113589	9186

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,844

Applicant(s)

INFOSINO, WILLIAM J.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-40, 42 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-57 is/are allowed.
- 6) ☒ Claim(s) 37-40, 42 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the amendment filed on 5/2/2003, which has been entered in the file. Claims 37-40, 42, and 51-57 are pending.

Claim Objections

2. Claims 42, 52, 56, and 57 are objected to because of the following informalities:

Claim 42, line 2: "t" should be replaced with --to--, in order to correct a typographical error.

Claim 52, line 2: --plurality of-- should be inserted after "the" in order to clarify the claim.

Claim 56, line 1: "a transaction" should be replaced with --the transaction data--, in order to clarify the claim and in order to clarify that the claim is referring to the step of storing a transaction data as recited in claim 52, line 11.

Claim 57, line 3: "the Internet" lacks proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37-40, 42 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (US 6,308,890 B1) in view of Lane (US 5,623,552, cited by applicant).

Cooper teaches a card (3) comprising: a memory (within control circuit 11, see column 3 lines 63-67) for storing a first account identification data and a second account identification data, a control (key pad 9) coupled to the memory for allowing a user to select either the first account identification data or the second account identification data, a re-writeable magnetic storage (programmable magnetic strip 4 or 10) region coupled to the memory, a device (within control circuit 11) for writing either the first or the second account identification data responsive to the control, wherein the control comprises a plurality of touch-sensitive pads (see column 2 lines 51-54), wherein the magnetic storage region comprises a magnetic stripe (see column 2 lines 48-49 and column 4 line 26), wherein the magnetic stripe is configured so as to be compatible with conventional magnetic stripe readers (see column 3 lines 15-26), wherein the first and the second account identification data includes data representing an account number (see figures 1-3, column 1 line 9 - column 2 line 16, column 2 line 46 - column 3 line 36, and column 3 line 60 - column 7 line 4).

Cooper fails to teach the card further including a fingerprint reader coupled to the memory, the device for writing being responsive to the fingerprint reader, a processor coupled to the fingerprint reader and the memory, the memory storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory.

Lane teaches a card (100) comprising: a memory (not labeled, but necessarily present) for storing a first account identification data (predetermined account

information), a re-writeable magnetic storage (109) region coupled to the memory, a device (110) for writing the first account identification data responsive to a control (controller 106/authenticator 107), the card further including a fingerprint reader (fingerprint sensor 102) coupled to the memory, the device for writing (110) being responsive to the fingerprint reader, a processor (controller 106/authenticator 107) coupled to the fingerprint reader and a memory (103), the memory (103) storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory (the magnetic stripe programmer 110 is responsive to an authentication signal from the controller 106/authenticator 107, see figures 1A, 1B, 2, column 2 lines 30-35, 54-63, column 5 line 6 - column 6 line 12, and column 8 lines 45-67).

In view of Lane's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card as taught by Cooper, a fingerprint reader coupled to the memory, the device for writing being responsive to the fingerprint reader, a processor coupled to the fingerprint reader and the memory, the memory storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory, in order to provide a self-authenticating card

which allows the card itself to authenticate the identity of the user, thereby protecting account information (see column 2 lines 10-35 and 54-63).

Allowable Subject Matter

5. Claims 52-57 have been allowed over the prior art of record (note that claims 52, 56, and 57 require the correction of the claim objections, listed above).

6. The following is an examiner's statement of reasons for allowance: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: a method for configuring a device that transforms a first card into another card selected from a plurality of cards, and confirming a transaction using one of the plurality of cards, the method including the steps of storing a first account identification data for a first card to a database; storing account identification data for a second card and a third card to the database; storing transaction data to the database, the database associating the transaction data with the account identification data of one of the second and third cards; and verifying a transaction using the transaction data; in combination with the other claimed limitations as set forth in the claims.

Cooper stores all of the account identification data within the card 3, and does not teach or suggest the steps of storing account identification data for first, second, and third cards to a database that is separate from the card 3. Thus, Cooper also does not teach or suggest the steps of storing transaction data to the database, the database associating the transaction data with the account identification data of one of the second and third cards.

Labaton (WO 94/17498) teaches a method for configuring a device (module 3) that transforms a first card into another card selected from a plurality of cards. Labaton teaches that account identification data may be downloaded, from a card-issuing company, to the memory of the device via computer, modem, telephone, or other device (see page 10, lines 22-33). Thus, the account information would necessarily be stored in a database at the account-issuing company. However, Labaton fails to specifically teach storing account identification for first, second, and third cards in a database (the same database). Thus, any assumption that Labaton would store account information for the first, second, and third cards in the same database would be based on improper hindsight.

Therefore, without a teaching from the prior art of record, there is no motivation for one of ordinary skill in the art at the time of the invention to combine or modify the prior art of record in a manner so as to create the invention as recited in claims 52-57.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

7. Applicant's arguments filed 5/2/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Cooper teaches away from limiting the use of the device to a single user by stating, "The operators may be human, animal or

otherwise, and may involve different operators of different persons or types at different times", and thus, discourages the use of a fingerprint reader coupled to the device for writing the account identification data (see page 6 of the amendment filed on 5/2/2003), it would be clear to one of ordinary skill in the art at the time of the invention that when Cooper discusses the invention as applied to a credit card, the operator of the credit card would be a human, not an animal. Furthermore, Lane suggests that multiple fingerprint information may be stored (see column 8, lines 45-67), and thus, the device would not have to be limited to a single operator, but any operator whose fingerprint information is stored.

In response to applicant's argument that Lane nowhere suggests permitting a user to select among multiple accounts (see page 6 of the amendment filed on 5/3/2003), Lane is not being relied upon for the teaching of permitting a user to select among multiple accounts, Cooper is being relied upon for this teaching. Lane is being relied upon for the teaching that account identification data should be available only to authorized users, a fingerprint reader coupled to a memory, and a device for writing account identification data being responsive to the fingerprint reader.

In response to applicant's argument that unlike Cooper, Lane, or any other reference of record, applicant's recognized that a device capable of writing multiple account information data on a card requires enhanced security (see page 7 of the amendment filed on 5/3/2003), Lane teaches that a device for writing account information data on a card requires security and authentication of the user. One of ordinary skill in the art at the time of the invention, would have recognized that this

teaching from Lane would equally apply to any device writing account identification data, no matter whether that device writes a single account identification data or multiple account identification data. Furthermore, Labaton provides evidence that it was generally known to those of ordinary skill in the art at the time of the invention that a device capable of writing multiple account information data on a card requires security (see page 11, lines 1-11, and page 13, line 13-17 of Labaton).

Thus, for the above reasons, a proper prima facie case of obviousness has been established.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paltenghe et al (US 2001/0011250 A1), Cuervo (US 2002/0174016 A1), Dethloff et al (US 4,837,422), Taylor (US 5,578,808), Wallerstein (US 5,955,961), Zacharias (US 6,494,367 B1), and Kern (WO 99/05633 A1) all teach systems and methods for storing account identification data.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

July 28, 2003

Jared J. Fureman
Jared J. Fureman
Art Unit 2876